

Remarks/Arguments

A. Status of the Claims

Claim 28 is amended, and no claims are added or canceled. Support for this revision can be found throughout the specification and claims as originally filed.

Claims 28-71 are pending.

B. Response to Restriction Requirement

1. Summary of Restriction Requirement

The Examiner requests restriction to one of the following two groups:

Group 1: Claims 28-61, drawn to a method.

Group 2: Claims 62-71, drawn to an article.

Restriction Requirement at page 2. In support of this, the Examiner states that “Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because...[t]he special technical feature for each group is not commonly shared.” *Id.* According to the Examiner, the claimed methods include “liquid phase chemical treatment” and a “vacuum evaporation with given speeds” which are not “mentioned in the article of group II.” *Id.*

2. Applicant Elects Group I with Traverse

Applicant elects Group I (claims 28-61) with traverse. A restriction between Groups I and II is improper. These groups share a single general inventive concept under PCT rule 13.1, as they share at least one special technical feature that defines a contribution over the cited art. This is explained in detail in the following subsections.

(i) Groups I and II share the same technical special feature

Group I: The Group I claims include two methods. The first method concerns a liquid phase chemical treatment of a MgF_2 temporary protective layer. The special technical feature of the first method includes forming a non-fluorinated metallic oxide (*e.g.*, MgO) and/or a

hydroxide (e.g., $\text{Mg}(\text{OH})_2$) layer in and/or on the MgF_2 temporary protective layer, the temporary layer being coated on an organic or mineral external layer of an ophthalmic lens. The second method concerns a deposition method on a MgF_2 temporary protective layer. The special technical feature of this method is a step of forming (by deposition) a magnesium oxide and/or a hydroxide layer on the MgF_2 temporary protective layer, the temporary layer being coated on an organic or mineral external layer of an ophthalmic lens. Therefore, methods 1 and 2 of Group I share a corresponding special technical feature of forming a non-fluorinated metallic oxide and/or a hydroxide layer on a MgF_2 temporary protective layer, the temporary layer being coated on an organic or mineral external layer of an ophthalmic lens. See claim 28.

Group II: The Group II claims concern an ophthalmic lens. Similar to the Group I claims, the special technical feature of the Group II ophthalmic lens is that the lens includes a non-fluorinated metallic oxide (e.g., MgO) and/or a hydroxide (e.g., $\text{Mg}(\text{OH})_2$) layer coated on a MgF_2 temporary protective layer, the temporary layer being coated on an organic or mineral external layer of the ophthalmic lens. See claim 62.

(ii) The shared special technical feature provides a contribution over the art

It cannot be disputed that Groups I and II share a special technical feature, that being obtaining an ophthalmic lens having an external organic or mineral layer coated with a MgF_2 temporary protective layer, the protective layer being coated with a non-fluorinated metallic oxide (e.g., MgO) and/or a hydroxide (e.g., $\text{Mg}(\text{OH})_2$) layer. This special technical feature provides a contribution over the art.

For instance, the specification explains that ophthalmic lenses having an organic or mineral external layer modify the surface energy of the lens. Specification at page 2. This surface modification can affect the adhesion between the pad/ophthalmic surface interface during

trimming of the lens, the consequence of which results in poorly trimmed lenses that can be unusable. *Id.*

One approach used to solve this adhesion problem is to deposit a MgF_2 temporary protective layer on the organic or mineral external layer of the lens. *Id.* This temporary layer can increase the adhesion between the pad and the surface of the lens. Under this approach, a period of 48 hours after applying the MgF_2 temporary coating typically has to pass before the trimming process can begin. *Id.* If trimming is attempted before 48 hours has passed, the pad “tends to detach itself from the lens spontaneously or under a very weak effort.” *Id.* This movement can cause problems during trimming.

The technical feature shared between Groups I and II solves the problems seen in the prior art. For instance, and in one non-limiting aspect of the invention, coating the MgF_2 temporary layer with a non-fluorinated metallic oxide (*e.g.*, MgO) and/or a hydroxide (*e.g.*, $\text{Mg}(\text{OH})_2$) layer enables the trimming operation to be performed relatively quickly after the various layers have been deposited on the lens (*e.g.*, less than 48 hours). *Id.*

(iii) The Group I method claims are specially adapted for the manufacture of the Group II ophthalmic lens claims

PCT Rule 13 recognizes that unity of invention can be established for claims of different categories such as product claims and process claims. The *Manual of Patent Examining Procedure* provides the following explanation:

The method for determining unity of invention under PCT Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(A) In addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product; or

MPEP § 1850 (III) (underlines added). The phrase “specially adapted means:

Thus, a process shall be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product with the technical relationship being present between the claimed product and claimed process. The words “specially adapted” are not intended to imply that the product could not also be manufactured by a different process.

Id.

Applicant's Group I method claims are specially adapted to make an ophthalmic lens that includes “a hydrophobic and/or oilophobic coating layer and a MgF_2 temporary protective layer on said hydrophobic and/or oilophobic coating layer, wherein a layer of at least one non-fluorinated metallic oxide and/or at least one non-fluorinated metallic hydroxide is on the MgF_2 protective layer.” Claim 62. By way of example only, method claim 28 concerns a method for treating an ophthalmic lens. The lens can include a hydrophobic and/or mineral coating. An MgF_2 temporary protective layer is coated on the hydrophobic and/or oilophobic coating layer. The MgF_2 temporary protective layer is coated with at least one non-fluorinated metallic oxide (*e.g.*, MgO and/or of at least one non fluorinated metallic hydroxide (*e.g.*, $\text{Mg}(\text{OH})_2$)). This confirms that the process of claim 28 results in the ophthalmic lens of claim 62. Further, the special technical feature is present in both the process and product claims (see above).

C. Conclusion

Restriction between Groups I and II is improper for at least the reasons stated above. Therefore, Applicant requests that this restriction be withdrawn and that all of the claims be examined in the next office action.

The Examiner is invited to contact the undersigned Attorney at (512) 536-3020 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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